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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,405	12/05/2001	Tonny Chen	BHT-3204-14	8170

7590 07/21/2004
BRUCE H. TROXELL
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH, VA 22041

EXAMINER

DOAN, KIET M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 07/21/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,405

Applicant(s)

CHEN, TONNY

Examiner

Kiet Doan

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81. No new matter may be introduced in the required drawing.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show in **claim 1**, lines 5 "which remote control circuit are house", lines 6-7 "buttons on said remote controller are pressed", lines 7-8 "cellular phone and the opposite end thereof is connected to a terminal" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the

drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 1 objected to because of the following informalities: The examiner believes the words "processing circuits", "dialing circuit" should be "processing unit", "dialing unit". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 3, 4, 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claim 1**,

page 18, line 10, the phrase "wireless remote control to make a dial" renders the claim indefinite and it is unclear whether the limitations applicant is intending to encompass. See MPEP § 2173.05(d).

Regarding **claim 2**,

page 19, line 9, the phrase "interface, or mounted somewhere to"

page 20, line 6, the phrase "(0-9, recording, playing...and functional terms of the like)"

page 20, lines 19-20, the phrase "(such as digits of 0-9, *, #, recording, playing,

augment, correction, end, SEND).

Renders those claim are indefinite and it is unclear whether the limitations applicant is intending to encompass. See MPEP § 2173.05(d).

Regarding **claim 3**,

page 21, lines 17-19, the phrase "(said infrared receiving unit being also used only for receiving infrared signals and decoding the same for the use of a rear end)"

page 22, lines 1-2, the phrase "(said infrared receiving unit can be simply a receiver of infrared signals and said decoding operation can be performed by a rear end unit)"

page 22, lines 11-12, the phrase "it usually being a coupling socket or connection cord of said hand-free set for use in connection to a cellular phone".

Renders those claim are indefinite and it is unclear whether the limitations applicant is intending to encompass. See MPEP § 2173.05(d).

Regarding **claim 4**,

page 23, lines 4,7, the phrase " capacitor (or resister)"

page 24, line 7, the phrase "various digital signal codes"

Renders those claim are indefinite and it is unclear whether the limitations applicant is intending to encompass. See MPEP § 2173.05(d).

Regarding **claim 5**,
page 24, lines 14,17, the phrase " capacitor (or resister)"
page 25, lines 15-16, the phrase "if said I/O interface is operating or not to a rear
terminal of "

Renders those claim are indefinite and it is unclear whether the limitations
applicant is intending to encompass. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to
comply with the enablement requirement. The claim(s) contains subject matter which
was not described in the specification in such a way as to enable one skilled in the art to
which it pertains, or with which it is most nearly connected, to make and/or use the
invention.

Regarding **claim 2**,
Page 18, lines 16-17, the phrase "a chief remote control unit being use to chiefly control
and coordinate individual components"

Page 19, lines 6-7, the phrase "a light detecting and light transmitting control unit being subject to the control of said chief remote control unit to direct operation of a light generating circuit"

Page 19, lines 11-12, the phrase " a signal transmission control unit converting codes of a dial coding unit into infrared signals"

Page 19, line 20, the phrase "a digital signal processing unit (voice identifying unit) processing signals transmitted"

Page 20, lines 7-8, the phrase " said digital signal processing unit (voice identifying unit) to output voice data stored in a data storage unit in phonic sound via speakers or corresponding circuit"

Page 20, line 11, the phrase "pre-recorded phonic guidance of said phone directory"

Page 20, line 12-13, the phrase " temporary storing signals of said man-to-machine interface for batch processing"

Page 20, lines 14-15, the phrase "a man-to-machine interface control circuit being subject to coordination of said chief remote control unit"

Render those claim are failing to comply with the enablement requirement, which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding **claim 3**,

Page 21, line 10, the phrase "a chief receiving control unit being used to dominate and coordinate operations of al unit"

Page 21, line 16-17, the phrase "and decoding the same for use of said rear connected chief receiving control unit (said infrared"

Page 22, line 7, the phrase "a communication detecting unit receiving communication signals"

Page 22, lines 8-9, the phrase " outputting signals to said chief receiving control unit to make the same aware of a current status of a cellular phone"

Render those claim are failing to comply with the enablement requirement, which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding **claim 4**,

Page 23, lines 19-20, the phrase " a flagpole control line being employed to transmit flagpole signals to a multiplexer control unit to indicate if said I/O interface has been in connection to a cellular phone or not"

Page 24, line 1, the phrase "a cellular phone working synchronic signal"

Page 24, lines 3-4, the phrase "such a synchronic signal input line having one end coupled to said cellular phone and the other end connected to a chief control unit of said I/O interface"

Render those claim are failing to comply with the enablement requirement, which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding **claim 5**,

Page 25, line 9-10, the phrase "a flagpole control line being employed to transmit flagpole signals to said multiplexer control unit to indicate if said I/O interface has been in"

Render the claim is failing to comply with the enablement requirement, which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claim 1** rejected under 35 U.S.C. 103(a) as being unpatentable over Nishihara (Patent No. 5,561,712) and further in view of Parvulescu et al. (Patent No. 5,802,460).

Consider **claim 1**, Nishihara teaches phone secretarial function extension device for a hand-free set comprising a wired or wireless remote controller (Title, Col 4, Lines 21-24 teach wireless controller) a receiver and an I/O (input/output) interface that are used to couple a hand-free set to a cellular phone (Col 5, Lines 16-29, Fig.1 teach receiver and I/O). Including, an end of said receiver is coupled to said hand free set of a cellular phone and the opposite end thereof is connected to a terminal of said I/O

interface (Col 13, Lines 49-66, Fig.3 teach hand free phone connected to terminal with I/O interface) one terminal of said I/O interface is coupled to said receiver and the other terminal is coupled to a signal terminal of said cellular phone whereby said receiver and a plurality of connection lines of said terminal of said cellular phone are integrally connected by way of said I/O interface (Col 7, Lines 1- 15, Col 13, 55-66, Col 16, Lines 23-25 are teach connected by way of said I/O interface). Nishihara teaches all the limitations of the claim but fail to teach wherein said wired or wireless remote controller is a freely portable unit having an interior in which remote control circuits are housed, said circuits are actuated to transmit remote control signals therefrom to said receiver as externally disposed buttons on said remote controller are pressed; in said receiver are disposed remote control signals receiving and processing circuits and a dialing circuit that are remotely actuated by said wired or wireless remote control to make a dial.

In an analogous art, Parvulescu et al. teach "Telephone Hand Set For Transferring Information To A Wireless Messaging Device". Further, Parvulescu et al. disclosed wherein said wired or wireless remote controller is a freely portable unit having an interior in which remote control circuits are housed (Col 4, lines 44-45, Fig.1, Fig.2 teach wireless remote circuit are house) said circuits are actuated to transmit remote control signals therefrom to said receiver as externally disposed buttons on said

remote controller are pressed (Col 4, Lines 44-47 teach transmit signal by dialing such as pressed buttons) in said receiver are disposed remote control signals receiving and processing circuits and a dialing circuit that are remotely actuated by said wired or wireless remote control to make a dial (Col 3, Lines 11-16, Col 4, Lines 45-65 both teach receive/transmit by remotely ad make dial)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to include, within Nishihara system, telephone handset with remote, as taught by Parvulescu et al. to modify a device that have secretarial function in a low cost to make all cellular phone users keep their old peripheral equipment.

Conclusion

The prior art made of record and not relied upon is consider pertinent to applicant's disclosed:

- | | |
|----------------------|--------------------------|
| 1. Nishihara | U.S patent No. 5,561,712 |
| 2. Parvulescu et al. | U.S patent No. 5,802,460 |
| 3. Kopp et al. | U.S patent No. 5,420,912 |
| 4. Kim et al. | U.S patent No. 6,560,469 |
| 5. Maymudes | U.S patent No. 6,748,278 |
| 6. Hahn et al. | U.S patent No. 6,078,825 |
| 7. Burke et al. | U.S patent No. 5,333,176 |
| 8. Nordwall | U.S patent No. 6,097,943 |

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet Doan whose telephone number is 703-305-4749. The examiner can normally be reached on 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kiet Doan
Patent examiner



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